

REMARKS

Claims 1-50 are all the claims pending in the application. Claims 1-50 presently stand rejected.

Claims 44, 46 and 50 are rejected under 35 U.S.C. § 112.

Claims 1, 7, 9, 12, 13, 15, 17, 19-21, 23-33, 35-38, 40-46 and 48-50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer et al. (USP 6,381,324) and in view of Applebaum et al. (USP 6,463,413).

Claims 2-5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer et al. (USP 6,381,324) and Applebaum et al. (USP 6,463,413) and further in view of S. Shaffer et al. (USP 5,950,165).

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer et al. (USP 6,381,324) and Applebaum et al. (USP 6,463,413) and in view of Skladman et al. (USP 6,438,215).

Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer et al. (USP 6,381,324) and Applebaum et al. (USP 6,463,413) in view of Porter (USP 6,282,270).

Claims 10, 11, 16 and 47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer et al. (USP 6,381,324) and Applebaum et al. (USP 6,463,413) and further in view of Cheston et al. (USP 6,330,308).

Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer et al. (USP 6,381,324) and in view of Applebaum et al. (USP 6,463,413) and S. Shaffer et al. (USP 5,950,165).

Claim 18 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer et al. (USP 6,381,324) and in view of Applebaum et al. (6,463,413) and Swan et al. (USP 6,351,222).

Claim 22 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer et al. (USP 6,381,324) and in view of Applebaum et al. (6,463,413) and Dauerer et al. (USP 6,311,177).

Claims 34 and 39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer et al. (USP 6,381,324) and in view of Applebaum et al. (USP 6,463,413) and Vysotsky et al. (USP 5,719,921).

§112 Rejection

In regard to the rejection under 35 U.S.C. §112, second paragraph, Applicant has amended the rejected claims as set forth in the attached Appendix. In particular, Applicant has amended claim 44 by changing the first reference to “the pronunciation” to --a pronunciation--, thus providing adequate antecedent basis for the term.

In regard to the §112 rejection of claim 46, Applicant respectfully points out to the Examiner that claim 46 depends from claim 44 and that claim 44 provides adequate antecedent basis for “the personal database” of the user.

With respect to the §112 rejection of claim 50, Applicant respectfully points out to the Examiner that there is only one “Internet” and it refers to a worldwide system of computer networks. The Internet is also sometimes referred to simply as “the Net”. Thus, any implication that more than one Internet exists, e.g., by reciting “an Internet” in claim 50, would be inaccurate.

Prior Art Rejections

In regard to the prior art rejections under 35 U.S.C. §103, for at least the following reasons Applicant respectfully traverses the rejections and requests favorable disposition of the application. Specifically, the asserted prior art references fail to teach or suggest the claimed system or method for automatic insertion of web-enhanced contact data into a personal address book.

In regard to claim 1, as well as the other independent claims, the Examiner asserts that Shaffer '324 teaches every recited element except for the recognition server comprising an automatic speech recognizer, a comparison unit or a textual directory. The Examiner asserts that Applebaum teaches the claimed recognition server, comparison unit and textual directory. Additionally, the Examiner asserts that "it would have been obvious" to one skilled in the art to modify Shaffer '324 to include the alleged recognition server of Applebaum "such that the modified system of Shaffer et al would be able to support the recognition server, comparison unit, and textual directory unit to the system users." However, the Examiner has provided no basis at all for such an assertion.

Indeed, at column 3, lines 14-17, Applebaum discloses, "[i]n the case of the address book, the application 20 can retrieve the appropriate address and telephone number using the alphanumeric text for the spoken name as provided by the speech recognizer 22." From reading Applebaum, however, it is clear that the disclosed device, e.g., a personal digital assistant (PDA) 10, is operable to retrieve stored information, e.g., names, addresses and telephone numbers, from a storage device within the PDA, e.g., lexicon 24. Applebaum discloses a method of searching based on the 'name' only. Unlike for the claimed invention where the system seeks

information other than the 'name' and the name acts as a filter. Moreover, neither Applebaum nor Shaffer '324 discloses a device that searches an electronic communications network, such as the Internet, to locate contact data, as explicitly required in the instant claims. The two prior art references cited are completely different than the system disclosed and claimed in the application.

In particular, in accordance to at least one embodiment of a personal address book disclosed and claimed in the present application, a verbalized form of a new contact name is converted into text form and compared to a collection of names, etc., which are stored in a storage device. One reason for performing this comparison is so the user can verify the spelling of the new contact name since some names that sound the same are spelled differently, e.g., Phillips, Filips, etc. Once the spelling of the new contact name has been verified, the text form of the new contact name is used by the textual directory unit to search the Internet to locate contact data, such as a corresponding address or telephone number. If contact data is located, the user selects those portions of the data that he or she wishes to have entered into the personal address book. Further, according to another embodiment, a number associated with the new contact, e.g., a telephone number, can be recorded and converted into text. The recorded number can then be used to conduct a search of the Internet to locate a name or other information associated with the new contact number.

As discussed above, Applebaum only discloses comparing a text version of a contact name with a stored library, or lexicon, of stored contact names. If a match is found, the data corresponding to that name is displayed, or otherwise retrieved, from within the device. New

data for new verbalized contact names is never sought in Applebaum. Thus, Applebaum does not, and can not, disclose the claimed textual directory unit that searches the electronic communications network.

Therefore, because the proposed combination of Shaffer '324 and Applebaum fails to teach or suggest at least the claimed textual directory unit of claim 1, claim 1 is not rendered obvious by the proposed combination and, thus, the rejection should be withdrawn. Moreover, for at least the same reason, the rejection of each of the other independent claims, i.e., claims 9, 29, 36 and 44, should be withdrawn as well, since each of these claims recites a similar feature, or features, to the textual directory unit of claim 1.

Dependent claims 2-8, 10-28, 30-35, 37-43 and 45-50 are also patentable over the asserted prior art combination at least based on their dependency from allowable claims 1, 9, 29, 36 and 44.

Lack of Motivation to Combine

Furthermore, the proposed combination of references is impermissible for §103 purposes since there exists no motivation, from within the prior art, for a skilled artisan to combine the independent teachings of Shaffer '324 and Applebaum. Absent impermissible hindsight reconstruction, i.e., without the knowledge gained from reading the present application, one of ordinary skill in the art would not have sought to combine the speech recognizer 22 and lexicon 24, of Applebaum, with the one number, multi-application, intelligent call processing system, disclosed in Shaffer '324. Other than to gain the benefits afforded by the claimed invention, those additional features of Applebaum serve no disclosed benefit in the system of Shaffer '324.

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 09/774,088

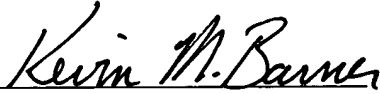
For this additional reason, the rejection of claims 1-50 under 35 U.S.C. §103 should be withdrawn.

Conclusion

In view of the foregoing remarks, the application is believed to be in form for immediate allowance with claims 1-50, and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Kevin M. Barner
Registration No. 46,075

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: November 26, 2003

Attorney Docket No.: Q61007